



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

First Named
Inventor : J. Martin Carlson et al.

Appln. No. : 10/027,949

Filed : December 21, 2001

For : SELF-ADHERING FRICTION REDUCING
LINER AND METHOD OF USE

Docket No.: T291.12-0013

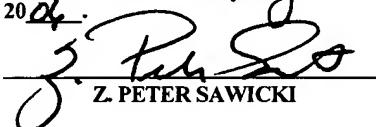
Group Art Unit: 3743

Examiner: H.A. Bennett

PRE-APPEAL REQUEST FOR REVIEW

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2006.

Z. PETER SAWICKI

Sir:

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

Claims 13-17 and 19-22 stand as rejected under 35 U.S.C. § 103(a) as being obvious over the combination of U.S. Patent No. 2,943,623 (Thompson) in view U.S. Patent No. 5,188,124 (Feret).

In the last Office Action, which was made final, the Examiner directed attention to Thompson column 2, lines 1-7 wherein the Examiner paraphrased what Thompson states as "The covering on the plaster can vary according to the application that is being applied to". (Page 2 of Office Action mailed on February 7, 2006) The Examiner then goes on to allege that in view of this broad teaching one of ordinary skill in the art would find it obvious to adjust the low friction covering on the plaster according to the application and for large areas to protect it would have been obvious to cover the entire plaster surface. Id. The Feret patent was cited as "Feret is primarily depended upon to teach that pressure sensitive adhesive is known to be used with low friction protection device". Id.

First, applicant respectfully disagrees as to the interpretation of column 2, lines 1-7 of Thompson. The Thompson patent is directed to corns and callouses, (indurations) and what Thompson states in column 2, lines 1-7 is that the dimension of the strip 12 (tetrafluoroethylene) and the length of the tape 14 (to which the tetrafluoroethylene is attached) "will of course vary depending on the induration to be covered. In all cases, polymerized tetrafluoroethylene strip 12 should be large enough to cover the frictional area of the particular induration."

Therefore, the disclosure in Thompson is that the tetrafluoroethylene should be large enough to cover the frictional area of the particular induration which does not suggest the idea of an entire patch having a low friction area. The teaching in Thompson is that the tetrafluoroethylene strip 12 (which is smaller than the patch or bandage) is to cover only the induration. The teaching in Thompson is not to cover the entire plaster (bandage) with tetrafluoroethylene.

The Feret patent although claiming to have a low friction embossed film, states that the co-efficient of friction is about 0.6. As stated in applicant's previous response, the co-efficient of friction of polytetrafluoroethylene is somewhere between .05 and 0.2. The co-efficient of friction disclosed in Feret is substantially higher and is for an entirely different polymer.

Claim 13 in contrast states that the selected patches are made of a material "having an exposed surface of low friction extending throughout the exposed surface within the peripheral edges wherein the surface has a co-efficient of friction substantially equal to that of polytetrafluoroethylene". (Lines 8-10) The peripheral edges are defined as to encircle an entire individual patch. (Lines 5, 6)

In *In re Dembicza*k, 175 F.3d 994, 50 U.S.P.Q. 2d 1614 (Fed. Cir. 1999), the Federal Circuit emphasized that, to reject an inventor's claim for obviousness in view of a combination of prior art references, a showing of a suggestion, teaching or motivation must be "clear and particular". The teaching in Thompson is not that it is "obvious to adjust the low friction covering on the plaster according to the application", but it is to cover the "induration". However, what the plaster is to cover, is not the issue. The issue is whether Thompson provides a teaching that the tetrafluoroethylene strip 12 extends continuously over the entire patch. This is the issue since this is what applicant is claiming. There is no teaching in Thompson, nor is there

any motivation or suggestion to extend the tetrafluoroethylene strip "throughout the exposed surface within the peripheral edges" as defined in claim 13 of this application. The only teaching that exists is applicant's specification. It is impermissible to use the inventor's disclosure as a "roadmap" for selecting and combining prior disclosures. In *Interconnect Planning Corp. v. Fell*, 774 F.2d 1132, 227 U.S.P.Q. 543 (1985), the Federal Circuit noted that "the invention must be viewed not with the blueprint drawn by the inventor, but in the state of the art that existed at the time".

The mere fact that prior art can be modified does **not** make the modification obvious unless the prior art taught or suggested the desirability of the modification. *In re Gordon*, 221 U.S.P.Q. 1125 (Fed. Cir. 1984). The Patent Office has the burden of establishing a *prima facie* case of obviousness. MPEP 2142; *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q. 2d 1438 (Fed. Cir. 1991).

As is clear from the above discussion, the Thompson has no teaching, suggestion or motivation to have the tetrafluoroethylene strip extend over the entire patch. The teaching in Thompson is that the tetrafluoroethylene should extend over the induration. Claim 13 of this application requires that the polytetrafluoroethylene extend "throughout the exposed surface within the peripheral edges" of the entire individual patch. (Line 9)

In view of this, it is believed that the obviousness rejection cannot be maintained and it is requested that the rejection be withdrawn and the claim allowed.

Respectfully submitted,

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